Remarks

The present claims are claims 1, 3, 4, 8 and 10. Nonelected claims 7 and 11-14 have been canceled as requested by the Examiner, as well as claim 9. Claim 2 has been incorporated into claim 1, and claim 9 has been canceled. The amendments are without prejudice in favor of continuing prosecution. Favorable reconsideration of this application is respectfully requested.

Claims 1 and 9 were rejected under 35 USC 102(b) as anticipated by any of Wu et al. '156 (US 6,203,156), Wu et al. '921 (US 2001/0013921) or Wu et al. EP '476 (EP 952,476). The present amendments obviate this rejection.

Claims 8 and 10 were rejected under 35 USC 103(a) as unpatentable over any of Wu et al. '156 (US 6,203,156), Wu et al. '921 (US 2001/0013921) or Wu et al. EP '476 (EP 952,476). Reconsideration is requested.

As previously pointed out in the last Amendment, the presently claimed invention concerns a method of making contact lenses. The general process of making lenses of concern here has three discernible portions: (a) making lens mold tools, b) using the tools to make lens molds, and (c) using the molds to make contact lenses. See the last full paragraph on page 1 of the specification and the last full paragraph of the specification. Identifying indicia are commonly used on contact lenses for the purposes described in the first paragraph of the Background of the Invention on page 1 of the Specification. Prior to this invention, one manner of making these indicia was acid etching the indicia into the mold tools, forming a mold from the tool which mold receives a negative image of the indicia, and then molding a contact lens from tool, the lens having the desired indicia in its surface. See again the last paragraph of page one of the specification.

The problem recognized by Applicants was the cracking and splitting of contact lenses (the product of the third portion of the inventive method) when using the prior methods of forming the indicia. The invention described in the specification and recited in the claims is the discovery that the cracking/splitting problem could be overcome by changing the method of etching indicia in mold tools in the first portion of the three-portion method of making contact lenses.

Turning to the cited references, Wu et al. '156 mentions "electrolysis" in a list of various methods (column 3, line 34). Similar disclosure is found in Wu et al. '921 in paragraph 20, and Wu et al. EP '476 at column 6, line 27. None of the Wu et al. references provide any teaching on

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how to conduct an electrolysis process. Further, Wu et al. equates electrolysis with various other methods of tool making, including acid etching, i.e., a method Applicant recognized that can lead to the cracking/splitting problem when used for contact lens indicia. Please see the same citations of the three Wu et al. references. Accordingly, it is respectfully submitted that the cited references: do not disclose or suggest the solution to the cracking/splitting problem as presently claimed; nor provide the requisite motivation for one skilled in the art to employ the first of the three part manufacturing process defined in present claim 1.

Accordingly, withdrawal of this rejection is respectfully requested.

Claims 2-4 were rejected under 35 USC 103(a) as unpatentable over any of the previous Wu et al. references, in view of Wertheimer (US 1,376,366). Reconsideration is requested.

It is respectfully submitted that Wertheimer does not cure the deficiencies of the Wu et al. references, discussed above. Like the Wu et al. references, Wertheimer does not disclose or suggest the solution to the cracking/splitting problem as presently claimed (and Wertheimer is especially irrelevant to this aspect in that Wertheimer is not concerned with contact lenses). Additionally, as the Wu et al. references teach a preference for methods other than electrolysis, one skilled in the art would not find the motivation to incorporate the methods of Wertheimer in the Wu et al. methods.

Accordingly, withdrawal of this rejection is respectfully requested.

The Examiner is invited to contact the undersigned to resolve any remaining issues.

Respectfully submitted,

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